Remarks/Arguments

In the Non-Final Office Action dated August 3, 2010, it is noted that claims 1-3, 5-9 and 11 are pending in this application and that all claims stand rejected under 35 U.S.C. §103.

Cited Art

The following list of references has been cited and applied against the claims in the present Office Action: U.S. Patent Application Pub. No. 2003/0063893 to Read (hereinafter referenced as "*Read*"); U.S. Patent 6,801,713 to Yagawa et al. (hereinafter referenced as "*Yagawa*"); and U.S. Patent Application Pub. No. 2002/0168175 to Green et al. (hereinafter referenced as "*Green*").

Rejection of Claims 1-3, 5-9, and 11 under 35 U.S.C. §103

Claims 1-3, 5-9 and 11 stand rejected under 35 U.S.C. §103 as unpatentable over Read, in view of Green, and further in view of Yagawa. These rejections are all respectfully traversed.

Claims 1 and 6 are independent claims having substantially similar limitations, although the claims are of different claim types and must be interpreted independently. Claims 2-3 and 5 depend directly from claim 1, whereas claims 7-9 and 11 depend directly from claim 6. The remarks below are intended to apply to both independent claims without further limitation, modification, or repetition.

Claim 1 recites:

> *"A method for time-shifting a presentation of multimedia content using a recorder comprising:*
> *receiving a first stream of multimedia content on a first channel;*
> *storing the first stream of multimedia content to a digital data store associated with the recorder;*
> *receiving a channel change request during said storing of the first stream;*
> *receiving a second stream of multimedia content on a second channel correlating to the channel change request;*
> *storing the second stream of multimedia content to the digital data store while retaining the first stream of multimedia content in the digital data store;*
> *receiving a rewind trick mode request;*
> *presenting the second stream of multimedia content in reverse; and*

> *presenting the first stream of multimedia content in reverse after reaching a beginning of the second stream of multimedia content."*

Neither Read, Green nor Yagawa, whether taken separately or in combination, teach, show, or suggest at least the above limitations in claim 1 and discussed in the remarks below. As noted above, claim 6 includes similar limitations to those reproduced above from claim 1. However, each claim must be interpreted independently.

On page 4 of the Office Action, it is admitted that Read does not disclose Applicant's claimed limitation for, "*storing the second stream of multimedia content to the digital data store while retaining the first stream of multimedia content in the digital data store.*" However, Read's teachings go beyond the mere lack of disclosure of this claimed feature.

Read appears to teach the concept of a channel change request without storing the new program channel. Moreover, Read clearly teaches away from the claimed invention. After a channel change, the new program correlated to the channel change request is **not** stored at all. For example, paragraph [0006] of Read states clearly that:

> *"Immediately after a channel change command is received, the PVR directs video directly to its output for display on a television display, bypassing the normal process of storing the video to the hard disk drive and then retrieving the video for display."* [Emphasis added].

Not only does Read fail to teach any step of storing the second stream after the channel change request, but Read expressly teaches that one should avoid storing the second stream at all in order to achieve the faster channel change desired in Read.

Green has apparently been combined with Read in order to cure the defect in the teachings of Read shown above. *See Office Action at page 4.* However, no teachings of Green (or even Yagawa) have been addressed to the express teach away by Read with respect to storing the second stream after the channel change. No teachings in Yagawa have been identified in the Office Action with respect to this aspect of the claimed invention. Therefore, it is concluded that the Examiner agrees that Yagawa lacks any teachings pertinent to this limitation of storing the second stream after the channel change while retaining the first stream in the digital data store.

Green appears to teach the ability to record a plurality of channels simultaneously through the use of multiple tuners. *See Green at paragraph [0055].* But Green does not teach or suggest

that his apparatus can retain a recording of a presently-viewed channel up to the point of a channel change while making the in-progress recording of the new channel, which is identified by the channel change. Green offers no teaching or reason to believe that his system reacts differently from other prior art systems after receiving a channel change request.

Prior art systems delete content stored for the previously tuned channel upon a channel change request. *See Applicant's specification at page 1, lines 19-20.* Without any express teachings to the contrary, it can only be assumed that Green operates in the very same manner as prior art systems upon receiving a channel change request. So, even though Green has the capability for recording multiple channels simultaneously, the presence of that capability alone cannot overcome Green's silence about how the system will respond to a channel change request. Since there is no teaching or suggestion that Green's system will somehow operate differently from the prior art systems, one can only conclude that Green's system will erase the previously viewed channel content upon a channel change.

Only Applicant has recognized that this aspect of the prior art poses a problem for the playback and trick mode because the prior art systems delete content stored for the previously tuned channel upon a channel change request. *See Applicant's specification at page 1, lines 19-20.* None of the cited prior art references mentions, recognizes, or even realizes this problem in the prior art systems., and none of the cited references indicates that it operates differently from the prior art systems when responding to a channel change request. Only Applicant diverges from the prior art teachings about deleting the content stored prior to the channel change, and realizes a method and apparatus to reach his ultimate playback and trick mode solution by "*storing the second stream of multimedia content to the digital data store* ***while retaining the first stream of multimedia content in the digital data store***." This is not a mode of operation or a result taught or suggested by Read, Green and Yagawa. Thus, Read, Green and Yagawa fail to teach, show or suggest all the limitations of claims 1 and 6 and the claims dependent thereon.

As an additional point of patentable distinction over the applied references, it should be noted that the combination of Green or any stream recording reference with Read is improper. Read clearly teaches away from recording the new channel content received after a channel change request, and expressly avoids recording that content so that he can effect a rapid channel change. Read recognizes that the recording of the content for the newly tuned channel will only

act to slow down the channel change and thwart his attempt to achieve a desired level of rapid response.

The combination of Read with any reference dealing with storing/recording content, whether from multiple channels or even from a newly changed channel, is contradictory to the purpose, the principles of operation, and the express teachings of Read. If Read is combined with such a storing/recording reference, it is believed that a "modified Read" will operate contrary to the very teachings of Read. Causing storage of the new content from the changed channel will negate any of Read's attempts to speed up the device operation. In other words, any modification of Read in this manner will render Read unsatisfactory for its intended purpose. When this occurs, it indicates that there is no motivation or suggestion to combine the references. *See MPEP §2143.01 especially subsections V and VI.* In view of Read's teachings away as described above and the remarks herein, it is submitted that the combination of Read, Green and Yagawa is improperly made and not motivated or suggested by the references themselves.

Contrary to the assertion in the Office Action, Yagawa does not teach or suggest "*presenting the first stream of multimedia content in reverse after reaching a beginning of the second stream of multimedia content*" as provided in Applicant's claimed invention. The Office Action admitted that Read and Green do not teach this limitation and that Yagawa has been combined with Read and Green to cure this defect in their teachings. *See Office Action at page 4.* Yagawa appears to show that recorded content can be indexed and searched by a viewer in preparation for a locating recorded content for viewing (playback), and various programs can be selected by a viewer for playback (e.g., Yagawa, Abstract and Fig. 9). Yet, there is no teaching or suggestion in Yagawa to playback the first stream of content in reverse after reaching the beginning of the second stream of content, wherein the first stream is associated with a recorded channel viewed prior to a channel change request and wherein the second stream is associated with a recorded channel viewed as a result of the channel change request. No programmed routine or user intervention is taught of suggested in Yagawa to accomplish the limitations of Applicant's claimed step.

Thus, Yagawa, Read and Green fail to teach, show, or suggest all the limitations of claims 1 and 6 and the claims dependent thereon.

In light of all the remarks above, it is submitted that the limitations of claims 1-3, 5-9 and 11 would not have been obvious to a person of ordinary skill in the art upon a reading of Read,

Green and Yagawa, whether taken separately or in combination. Thus, claims 1-3, 5-9, and 11 are allowable under 35 U.S.C. §103. Withdrawal of this rejection is respectfully requested.

Conclusion

In view of the foregoing, it is submitted that all the claims pending in this patent application are in condition for allowance. Entry of this amendment, reconsideration of this application, and allowance of all the claims are respectfully solicited.

Respectfully submitted,

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